THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GRACE SAMOIL, DANIEL COLODNEY
and CARMEN Y. BONTA

_____

Appeal No. 1997-2027
Application 08/417,419[1]

_____

ON BRIEF

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Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 16-32, all the claims currently pending in

[1] Application for patent filed April 5, 1995. According to the appellant, the application is a division of Application 07/924,139, filed August 3, 1992.

the application.

Background

The subject matter on appeal in this application is related to the appealed subject matter in parent application 07/924,139. In Appeal No. 95-4329 in the parent application, a merits panel of this Board affirmed the examiner's decision finally rejecting the appealed claims thereof.

The Invention

Appellants' invention pertains to a method of controlling the dose of dentifrice used for a brushing of teeth. As stated on page 3 of the specification:

> [The] invention is directed to a color coded toothbrush that is designed to instruct as to the proper dose of dentifrice to use for a brushing. The toothbrush has bristles of at least two different colors. The bristles of a first color are in a number such that when a dentifrice is deposited only on these colored bristles of the toothbrush the person will be using only about 0.1 grams to about 0.75 grams of dentifrice, and preferably about 0.1 grams to about 0.4 grams of dentifrice. The amount will depend to a large degree on the end surface area of the tufts bristles onto which the dentifrice is to be deposited.

Independent claim 16 is illustrative of the appealed

subject matter and reads as follows:

16. A method of controlling the dose of dentifrice used for a brushing comprising providing a toothbrush wherein the bristles are comprised of at least two different colors and wherein the bristles of one color provide a pattern such that when the bristles of said pattern support a dose of dentifrice deposited thereon the dose is from about 0.1 to 0.75 grams of dentifrice, and depositing a dose of dentifrice onto said bristles of said pattern to substantially cover said bristles of said pattern and to deposit a dose of dentifrice of about 0.1 to about 0.75 grams thereon.

The Prior Art

The following reference is relied upon in support of a rejection under 35 U.S.C. § 103:

Fleischer 2,795,043 Jun. 11, 1957

In addition, the examiner relies on appellants' admitted prior art (AAPA) as set forth on page 2 of the specification.

Page 2 of the specification reads as follows:

> There are brushes that have a multi-color bristle pattern. However, there are no toothbrushes where the bristles are color coded so as to regulate the dose of dentifrice that is used. In various prior art toothbrushes the bristles are of different colors for decorative purposes, to serve as an indicator when the brush should be changed, or to instruct as to proper brushing techniques. U. S. Patent 3,188,673 discloses a toothbrush that has different color bristles in order to instruct children the proper brushing techniques. In this

> patent there is shown the use of blue and white bristles or green and white bristles. In U. S. Patent 4,403,623 the bristles appear to be of two different colors. In this instance the bristles of one color are softer than the bristles of another color. . . . In U. S. Patent 4,802,255 there is shown a brush where some of the bristles have a dye that has penetrated part of the distance through the bristle. During usage this dye is gradually dissipated with the effect that when the dye is almost fully lost from the bristles that this is time to replace the brush.

The Rejection

Claims 16-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over AAPA in view of Fleischer.

On page 4 of the specification, the examiner finds that Fleischer

> . . . teaches devices for the measurement and administration of medicines and a method for use of the same. The devices generally consist of a spoon shaped article in which one portion contains calibrated containing means marked with “suitable indicia” for measuring the dose to be administered, thereby preventing an excessive dose from being transferred to the patient (col. 2, lines 39-62). The general teachings are the use of a single device in which a required dosage is measured by the use of calibrated indicia and then the same device is used to orally administer that dose to the patient.

Based on these findings and the AAPA teachings, the

examiner concludes:

> . . . the Admitted Prior Art with the teachings of Fleischer would have fairly suggested to one of ordinary skill in the art to use calibrated markings to measure out a dose of an effective dental agent, such as "pea size amounts" of dentifrices, onto a toothbrush which is then used to administer that dosage. One skilled in the art of dentifrices would have reasonably looked to analogous medicals [sic, medical] arts to find solutions to administering safe but effective dosages of materials of a medicinal nature. The use of indicia to calibrate an effective dose is taught by Fleischer without limitation as to color or design. Since indicia are merely markings, this would encompass linear markings or patterns in outline or of a single color as long as the pattern was calibrated to be representative of the dose to be administered. The combination of references therefore would have suggested the use of calibrated indicia, including a first colored area or certain shape on a toothbrush for a child's dose, within or adjacent to a second color or shape so as to provide the user with guidance as to [the] amount of toothpaste to be deposited thereon. The method of use would be the depositing of the dose substantially within the calibrated area as marked by indicia, and then the administration of that does from the same device. [Answer, pages 4-5.]

Opinion

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In making such a rejection, the examiner has the initial duty

of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id*.

In the present case, the examiner has inappropriately generalized the teachings of Fleischer far beyond what one of ordinary skill in the art would have reasonably gleaned therefrom in an vain attempt to find some common ground between the claimed method and the applied prior art. This hindsight analysis of what Fleischer would have suggested to the ordinarily skilled artisan is improper. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (*see In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Here, the examiner's conclusions of obviousness are based on a hindsight reconstruction of the claimed invention from isolated disparate teachings in the prior art. It follows that the examiner's rejection of claims 16-32 as being unpatentable over the combined teachings of AAPA and Fleischer cannot be

sustained.

Remand to the Examiner

The presently appealed claims are directed to a method of controlling the dose of dentifrice whereas the appealed claims in the earlier mentioned parent application 07/924,139 were directed to a toothbrush for controlling the dose of dentifrice. Notwithstanding this difference, we are struck by the similarity between the presently appealed claims and those involved in the appeal in the parent application. In particular, the merits panel in the prior appeal found that the claims on appeal therein

> are completely silent as to whether the remaining bristle ends on the toothbrush head are covered or not covered by dentifrice. Thus, as the examiner has correctly observed, there is no limitation as to the **total** amount of dentifrice that can be deposited on all
>
> of the bristle ends on the toothbrush head taken as a whole. That is, insofar as the claims on appeal are concerned, **all** of the bristle ends (including the bristles of both colors in claim 1 . . .) could be covered with dentifrice and the limitations of these claims still be satisfied. [Prior decision, page 6.]

In that at least independent claim 16 on appeal here also is silent as to whether or not toothpaste is applied to the

bristles of the color not making up the pattern, the above quoted remarks apply as well to at least independent claim 16.

In affirming the examiner's rejection of the appealed claims in the prior appeal based on Best, the merits panel went on to state:

> The amount of surface area covered, as well as all of these "other factors," normally very among users dependent upon the habits of a particular user, and may even vary from day-to-say with respect to a particular user. *Considering all these variables, we believe that the examiner had a reasonable basis to conclude that when the toothbrush of Best is used in a normal and customary manner that, at least at some point in time, the claimed amount of dentifrice would be deposited on Best's pattern by the users thereof.* This is particularly the case, considering the relatively large ranges being claimed as to the amount of dentifrice deposited (0.1 to 0.75 grams in the case of claims 1-3, 5-11 and 13-15 and 0.1 to 0.4 grams in the case of claims 4 and 12). [Prior decision, page 7; emphasis added.]

In light of the above, the examiner is urged to consider the Best reference[2] cited by the examiner against the claims in the parent application and the rationale of the merits panel in affirming the examiner's rejection based thereon. In

[2] The Best reference (i.e., French patent 1,233,465, with translation) has been made of record in the present application by appellants in an Information Disclosure Statement filed August 25, 1995 (Paper No. 6).

particular, the examiner should consider whether claim 16 and any other of the pending claims in the present application patentably distinguish over Best.

Summary

The final rejection of claims 16-32 as being unpatentable over AAPA in view of Fleischer is reversed.

This application is remanded to the examiner for consideration of the patentability of the appealed claims in light of the Best reference, of record.

The decision of the examiner is reversed.

REVERSED AND REMANDED

NEAL E. ABRAMS Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

LJS/pgg
Michael J. McGreal
Colgate-Palmolive Company
909 River Road
Piscataway NJ 08855